UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,975	07/25/2001	Suellen Kae Birkholz	ROC920010108US1	6558

7590	05/16/2005

Gero G. McClellan
Thomason, Moser & Patterson, L.L.P.
Suite 1500
3040 Post Oak Boulevard
Houston, TX 77056-6582

EXAMINER
NGUYEN BA, HOANG VU A

ART UNIT	PAPER NUMBER
2192	

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/912,975	BIRKHOLZ ET AL.
	Examiner	Art Unit	
	Hoang-Vu A. Nguyen-Ba	2192	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 April 2005 and 15 April 2005*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *12-14 and 26* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *12-14 and 26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *25 July 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
        application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)	4)☐ Interview Summary (PTO-413)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)	5)☐ Notice of Informal Patent Application (PTO-152)
Paper No(s)/Mail Date _____ .	6)☐ Other: _____ .

U.S. Patent and Trademark Office
PTOL-326 (Rev. 1-04)   Office Action Summary   Part of Paper No./Mail Date 20050426

DETAILED ACTION

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submission filed on April 21, 2005 and Response to Notice of Non-compliant Amendment to Final Office Action, dated January 21, 2005, filed on April 15, 2005 have been considered.

Response to Amendments

2.   Per Applicants' request, claims 1-11, 15-25 and 27 have been canceled; claims 12-14 and 26 have been amended. Claims 12-14 and 26 remain pending.

Response to Arguments

3.   The rejection of claims 1-11, 15-25 and 27 under 35 U.S.C. § 102(b) as being anticipated by Fawcett is withdrawn in view of Applicants' cancellation of these claims.

4.   The rejection of claims 12, 13 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Fawcett in view of Hellerstein is withdrawn in view of Applicants' filing of the Statement of Common Ownership of the present application and the U.S. Publication No. US2002/0129356 at the time the invention of the present application was made.

Double Patenting

5.   The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent

the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Long*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1993); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Voge*, 422 F2.d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F2.d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminated disclaimer in compliance with 37 CFR 1.103(c) 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6.   Claims 12-14 and 26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent Application Publication No. 2002/0129356 By Hellerstein et al. ("Hllerstein").

This is a provisional obviousness-type double patenting since none of the applications have been patented yet.

7.

Present Application Claim 13	Publication Claim 1+3
A method of upgrading a software on a customer system, comprising:	A computer-based method of performing automated distribution of a software package to one or more target machines in one or more regions of a distributed network of target machines, the method

	comprising: (Claims 1/3)
receiving, by a supplier system, a **software inventory** from the customer system;	preparing a base software package for each of the one or more regions based on at least one of : (iii) **configuration information** for each of the candidate regions (**Claim 1**) customizing the base software package received at each of the candidate regions based on at least one of: (iii) individual target machine **configuration information**; and (**Claim 1**)
verifying one or more **business contracts** for the software inventory utilizing one or more databases connected to the supplier system;	(i) **policy data** indicating which of the one or more regions are candidates for receiving the software package; (**Claim 1**) customizing the base software package received at each of the candidate regions based on at least one of: (i) **regional distribution policies**; (**Claim 1**)
determining one or more software upgrade releases for the software inventory utilizing a product **topology** database connected to the supplier system;	the method of claim 1, wherein the dependency indicating requisites for a service provided by the software package is represented in the form of a **multi-level tree**; (**Claim 3**)
receiving an order for additional software;	

and	
verifying **pre-requisite and corequisite software** for the additional software.	(ii) **dependency information** indicating requisites for a service provided by the software package; (**Claim 1**) customizing the base software package received at each of the candidate regions based on at least one of: (ii) **dependency information** specific to one or more roles performed by the target machines of that region (**Claim 1**)
	distributing the base software package to each of the candidate regions of the distributed network; (**Claim 1**)
	distributing the software package customized in each of the candidate regions to at least one of the target machines in the candidate regions of the distributed network. (**Claim 1**)

As can be seen from the above table, although the conflicting claims are not identical, they are not patentably distinct from each other because present claim 13 and publication claims 1+3 are obvious variants of each other.

The limitation of present claim 13 that is lacking in publication claims 1+3 is that of "receiving an order for additional software." However, this limitation is deemed inherent to the method of publication claims 1+3 as these claims recite the steps of preparing, customizing and distributing a base software package. Without the

receiving an order of additional software step, there is no need for the steps of preparing, customizing and distributing a base software package.

The limitations of the publication claims 1+3 that are lacking in present claim 1 are "distributing the base software package to each of the candidate regions of the distributed network" and "distributing the software package customized in each of the candidate regions to at least one of the target machines in the candidate regions of the distributed network." However, these two steps are deemed inherent to the method of present claim 13 because the method of present claim 13 relates to the upgrading of software on a customer system, which requires, *inter alia*, sending an order for software and receiving by the supplier system of software inventory of the customer system. Without the distributing steps, the customer system could not receive the ordered software package.

8.

Present Application Claim 14	Publication claims 10+19
A system for upgrading a software on a customer system, comprising:	A system for performing automated distribution of a software package to one or more target machines in one or more regions of a distributed network of target machines, the system comprising: **(Claims 10/19)**
a supplier system configured to:	a service distribution server, the service distribution server being operative to:
receive a **software inventory** from the customer system;	prepare a base software package for each of the one or more regions based on at least one of : **configuration information**

	for each of the candidate regions **(Claim 10)**; one or more repositories for storing the **configuration information** for each of the candidate regions **(Claim 19)**
verifying one or more **business contracts** for the software inventory utilizing one or more databases connected to the supplier system;	prepare a base software package for each of the one or more regions based on at least one of: **policy data** indicating which of the one or more regions are candidates for receiving the software package; **(Claim 10)**; customize the base software package, when received, based on at least one of **regional distribution policies**; **(Claim 10)**
determine one or more software upgrade releases for the software inventory utilizing a product **topology database** connected to the supplier system;	one or more **repositories** for storing the policy data indicating which of the one or more regions are candidates for receiving the software package **(Claim 19)**
wherein determining one or more software upgrade releases comprises verifying **pre-requisite** and **corequisite** software for the additional software.	dependency information indicating **requisites** for a service provided by the software package; **(Claim 10)** dependency information specific to one or more roles performed by the target machines in the region of the region

	server; **(Claim 10)** the dependency information indicating **requisites** for a service provided by the software package; **(Claim 19)**
	and distribute the base software package to each of the candidate regions of the distributed network; **(Claim 10)**
	distribute the customized software package customized to at least one of the target machines in the region of the region server. **(Claim 10)**

As can be seen from the above table, although the conflicting claims are not identical, they are not patentably distinct from each other because present claim 14 and publication claims 10+19 are obvious variants of each other.

The limitations of the publication claims 10+19 that are lacking in present claim 14 are "distribute the base software package to each of the candidate regions of the distributed network" and "distribute the customized software package to at least one of the target machines in the regions of the region server." However, these two steps are deemed inherent to the method of present claim 14 because the method of present claim 14 relates to the upgrading of software on a customer system, which requires, *inter alia*, sending a request for software upgrade and receiving by the service distribution server software inventory of the customer system. Without the distributing steps, the customer system could not receive the requested software package.

9.   With respect to present claims 12 and 26, these claims anticipate publication claims 1+3 and 22, respectively because the method steps of verifying pre-requisite and corequisite software for the software upgrade releases (filtering, categorizing, mapping, categorizing and generating...) recited in present claims 12 and 26 are not patentably distinct from the method of verifying dependency information indicating requisites for a service provided by the software package recited in publication claims 1+3 and 22. None of the publication claims besides 1+3, 10, 22 appear to recite a method that is distinct from the one detailed in present claims 12 and 26 (filtering, categorizing, mapping, categorizing and generating...) for verifying pre-requisite and corequisite software of the software upgrade releases. Therefore, although the conflicting claims are not identical, they are not patentably distinct from each other.

Conclusion

10.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang-Vu "Antony" Nguyen-Ba whose telephone number is (571) 272-3701. The Examiner can normally be reached on Tuesday-Friday, 7:15 to 17:15.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Tuan Dam can be reached at (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov.

Should you have questions on access to the Private PAIR system, contact the

Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**ANTONY NGUYEN-BA
PRIMARY EXAMINER**

Art Unit 2192

April 26, 2005